

### **REMARKS**

Applicants file concurrently herewith a Request for Continued Examination (RCE) in response to the final Office Action mailed June 12, 2008 (hereinafter, "Office Action"). In the Office Action, the Examiner rejected claims 1-9, 12-16, and 18-26 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,483,049 to Schulze, Jr. et al. (hereinafter, "Schulze"); and rejected claims 10, 11, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Schulze.

By this response, Applicants hereby amend claims 1-3, 5-7, 9-18, 21-23, and 25-26. No new matter has been added. Accordingly, claims 1-26 are currently pending.

In light of the foregoing amendments and based on the remarks presented below, Applicants respectfully traverse the rejections of the claims under 35 U.S.C. §§ 102(b) and 103(a), and request the allowance of pending claims 1-26.

#### **I. Rejections Under 35 U.S.C. § 102(b)**

Applicants respectfully traverse the rejection of claims 1-9, 12-16, and 18-26 under 35 U.S.C. § 102(b) as being anticipated by Schulze. "A proper anticipation rejection requires that "each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131. In addition, "[t]he elements must be arranged as required by the claim . . . ." Id. (emphasis added). Applicants respectfully submit that Schulze fails to disclose all of the subject matter recited in independent claims 1, 13, 18, and 22, and also fails to disclose the elements as arranged by the independent claims.

**A. Claims 1-9 and 22-26**

Schulze fails to teach, *inter alia*, "creating a first partnership check such that the first partnership check includes a routing number . . ." and "associating the first partnership check with a customer based on an account number associated with the customer," as recited in amended independent claim 1. Instead, Schulze discloses that "the coupon exchange system 20 also includes one or more coupon scanning check writers 44 used for redeeming coupon exchange coupons 40 for checks 48 which are printed and presented to the consumer as redemption for the coupon exchange coupons 40." Id. at 3:67 - 4:5. In contrast to Applicants' claim 1 recitation, Schulze explicitly discloses that "the checks 48 are drawn on an account specific to the enterprise operating the coupon exchange system 20." Id. at 10:18-22 (emphasis added). Accordingly, the coupons or checks collected by a user based on the coupons, do not include a partnership check that is associated with a customer based on an account number for that customer.

Moreover, while the Examiner attempts to draw a correspondence between Schulze's "coupons 40" and Applicants' claimed "partnership check," such an allegation is without basis. Office Action, p. 2. At a minimum, the "coupons 40" of Schulze do not include a routing number. Thus, Schulze's coupons cannot correspond to a partnership check that includes a routing number, as recited in Applicants' amended independent claim 1.

Accordingly, for at least the above-outlined reasons, Schulze fails to disclose all of the subject matter recited in Applicants' amended independent claim 1. Therefore,

the rejection of independent claim 1 under 35 U.S.C. § 102(b) is legally deficient, should be withdrawn, and the claim allowed.

Amended independent claim 22, although of different scope, recites elements similar to those of amended independent claim 1, and is therefore allowable for at least the same reasons. Therefore, the rejection of amended independent claim 22 under 35 U.S.C. § 102(b) is legally deficient, should be withdrawn, and the claim allowed.

Claims 2-9 depend from amended independent claim 1, and claims 23-26 depend from amended independent claim 22. As discussed above, Schulze does not support a rejection of independent claims 1 and 22. Therefore, dependent claims 2-9 and 23-26 are allowable for at least the same reasons as set forth above in connection with their corresponding independent claims.

**B. Claims 13-16 and 18-21**

Schulze also fails to disclose the recitations of amended independent claim 13, including, *inter alia*, "providing, on each of the partnership checks, indicia that is indicative of a predetermined transaction amount, an account number associated with a respective customer of the plurality of customers, and a routing number." As discussed above in connection with amended independent claim 1, Schulze does not disclose "an account number associated with a respective customer of a plurality of customers," as recited in amended independent claim 13. Instead, Schulze explicitly discloses that "the checks 48 are drawn on an account specific to the enterprise operating the coupon exchange system 20." Id. at 10:18-22 (emphasis added).

Moreover, as also discussed above in connection with Applicants' amended independent claim 1, the Examiner incorrectly attempts to draw a connection between

Schulze's "coupons 40" and Applicants' claimed "partnership check." As explained, the "coupons 40" of Schulze do not include a routing number, and therefore necessarily cannot include "indicia that is indicative of . . . a routing number," as also recited in Applicants' amended independent claim 13.

Accordingly, for at least the above-outlined reasons, Schulze fails to disclose all of the subject matter recited in Applicants' amended independent claim 13. Therefore, the rejection of independent claim 13 under 35 U.S.C. § 102(b) is legally deficient, should be withdrawn, and the claim allowed.

Amended independent claim 18, although of different scope, includes a recitation similar to that of amended independent claim 13. For at least the same reasons as discussed above in connection with amended independent claim 13, Schulze fails to disclose all of the subject matter recited in Applicants' amended independent claim 18. Therefore, the rejection of independent claim 18 under 35 U.S.C. § 102(b) is legally deficient, should be withdrawn, and the claim allowed.

Claims 14-16 depend from amended independent claim 13. Claims 19-21 depend from independent claim 18. As discussed above, Schulze does not support a rejection of independent claims 13 and 18. Therefore, dependent claims 14-16 and 19-21 are allowable for at least the same reasons as set forth above in connection with their corresponding independent claims.

## **II. Rejection Under 35 U.S.C. § 103(a)**

The Examiner rejects claims 10, 11, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Schulze. To support this position, the Examiner takes Official Notice.

See Office Action, p. 3. As explained below, Applicants traverse the taking of Official Notice in the Office Action and respectfully request the Examiner to provide authority to support the Examiner's position.

A general allegation that something may be "well known" is not sufficient to support a taking of Official Notice. "[T]he basis for [the examiner's] reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." See [In re Soli, 317 F.2d 941, 137 U.S.P.Q. 797 (CCPA 1963)], 317 F.2d at 946, 37 USPQ at 801; [In re Chevenard, 139 F.2d 711, 60 U.S.P.Q. 239 (CCPA 1943)], 139 F.2d at 713, 60 USPQ at 241. "The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." M.P.E.P. § 2144.03(B).

In the Office Action, the Examiner rejected claims 10, 11, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Schulze. To support this position, the Examiner took Official Notice. See Office Action, pp. 3-4. According to the Examiner, "inserts (claims 10 and 17) with the mailed coupon/check and an incentive chosen so as to maximize profit (claim 11) . . . were in common use, and therefore obvious to one of ordinary skill in the art, at the time of the instant invention." Office Action, p. 3.

However, in taking Official Notice, the Office Action failed to address the other claim recitations, and further failed to provide any reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of Schulze. A general allegation that something may be "well known" is not sufficient to

support a taking of Official Notice. "[T]he basis for [the examiner's] reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." M.P.E.P. § 2144.03(B) (internal citations omitted) (emphasis added).

It is the **Examiner's burden** to present the explicit basis for taking Official Notice. "The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." *Id.* In the Office Action, however, the Examiner stated that "applicant has not provided adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the official notice . . . [and] [t]he examiner's taking of official notice is maintained." Office Action, p. 3. This conclusion is in violation of M.P.E.P. § 2144.03.

Applicants can only rebut the taking of Official Notice to the extent that the Examiner has provided "sound technical and scientific reasoning to support his or her conclusion of common knowledge." M.P.E.P. § 2144.03(B) (internal citations omitted). To reject three claims, the Examiner merely states that "inserts (claims 10 and 17) with the mailed coupon/check and an incentive chosen so as to maximize profit (claim 11) . . . were in common use, and therefore obvious to one of ordinary skill in the art, at the time of the instant invention." Office Action, p. 3. In other words, the Examiner provided no reasoning, only stating that these items were in common use and obvious, and in rebuttal to Applicants' traversal, states that "the presentation of a reference to

substantiate the official notice is not deemed necessary." Office Action, p. 5. This is improper.

Moreover, to establish *prima facie* obviousness under 35 U.S.C. § 103(a), the Office Action must show, *inter alia*, that the applied reference teaches each and every element recited in the claims. M.P.E.P. § 2143. Here, by ignoring the recitations of claims 10, 11, and 17, the Office Action has failed to show how the cited art purportedly discloses the recitations of these claims. Specifically, the Office Action has failed to show how Schulze discloses "sending informative inserts to the customer with the first partnership check," as recited in dependent claim 10. In addition, the Office Action has failed to show how Schulze discloses "providing an economic incentive with the plurality of partnership check for each customer that uses at least one of the plurality of partnership checks, wherein a type of the economic incentive is determined based on maximizing profit for an issuer of the plurality of partnership checks and the one merchant," as recited in dependent claim 11. Additionally, the Office Action has failed to show how Schulze discloses "sending partnership checks to the plurality of customers with information material," as recited in dependent claim 17. Thus, the rejection of dependent claims 10, 11, and 17 does not meet the requirements of at least M.P.E.P. § 2143 and 35 U.S.C. § 103(a), and is therefore legally improper.

Furthermore, as noted above, Schulze does not teach or suggest "associating the first partnership check with a customer based on an account number associated with the customer," as recited in amended independent claim 1, from which claims 10 and 11 depend. Nor does Schulze teach or suggest "providing, on each of the partnership checks, indicia that is indicative of a predetermined transaction amount, an

account number associated with a respective customer of a plurality of customers, and a routing number," as recited in claim 13, from which claim 17 depends.

For at least these reasons, Schulze does not teach or suggest all the elements of Applicants' dependent claims 10, 11, and 17. Therefore, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a), and the allowance of claim 10, 11, and 17.

### **III. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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